

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Claims 1-17 are pending in the present application. Claims 1-3 and 6-13 have been amended. Claims 14-17 have been added.

No new matter has been added by way of these amendments and new claims because each amendment and new claim is supported by the present specification. For example, the amendment to claim 1 is supported by the present specification at, for instance, page 7, lines 22-24 and page 8, lines 10-11. The amendments to claims 2-3 are editorial in nature. These are clarifying and not narrowing amendments. The amendment to claim 6 is supported by original claim 1 and page 7, lines 22-24, page 8, lines 10-11, page 9, lines 14-17, the paragraph bridging pages 10-11, and page 13, lines 17-25 of the specification. The amendments to claims 7-13 are supported by the originally filed claims and throughout the present specification. New claims 14 and 16 have support at page 3, line 20. New claims 15 and 17 are supported at page 8, lines 10-11. Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Reply to Office Action of March 3, 2003

Issues Under 35 U.S.C. § 102

Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Grigoriev et al. (U.S. Patent No. 4,226,965; hereinafter referred to as "Grigoriev '965"). Also, claims 1-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Iseki et al. (U.S. Patent No. 6,288,193 B1; hereinafter "Iseki '193"). Applicants respectfully traverse since these references fail to disclose all features as instantly claimed. Reconsideration and withdrawal thereof are respectfully requested.

The present invention is directed to a copolymer consisting of units derived from propylene and units derived from a vinyl compound (I) (i.e., see the features of claim 1). The vinyl compound (I) is represented by the general formula $\text{CH}_2=\text{CH}-\text{R}$ (wherein R is a hydrocarbon group, the steric parameter of ES of the substituent R is -1.64 or less and the steric parameter of B1 of the substituent R is 1.53 or more).

In contrast to the present invention, the cited Grigoriev '965 reference fails to disclose a copolymer of propylene and vinylcyclohexane. In fact, Grigoriev '965 describes polymers and copolymers of higher α -olefins having a number of carbon atoms in a molecule of more than 3 (see Col. 1, lines 5-8; Col. 3, lines 27-29). Grigoriev '965 even claims polymers and copolymers of higher α -olefins having 4 to 8 carbon atoms (see claim 1 at Col. 10 of this reference). Further, the Examples of Grigoriev '965 do not disclose propylene, or

the recited steric parameters as instantly claimed. Thus, there is no disclosure in Grigoriev '965 of all claimed features.

Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Grigoriev '965 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Grigoriev '965 is overcome. Reconsideration and withdrawal of this rejection is respectfully requested.

Applicants respectfully further submit that the Grigoriev '965 reference does not provide any motivation to use propylene instead of the higher olefins, or further using a combination of propylene with the higher olefins.

Similar to the Grigoriev '965 reference, Iseki '193 fails to disclose all features as instantly claimed. The copolymers disclosed in the Iseki '193 reference contain ethylene units in the copolymers as an essential component. However, Iseki '193 fails to disclose the copolymer as instantly claimed (which do not contain the cited ethylene unit).

In addition, the Iseki '193 fails to teach or suggest the features of the other pending claims. For example, there is no disclosure in

this reference of the adhesives of claims 6-9, wherein the claimed adhesive or laminate contains the copolymer plus a specific solvent in a specified amount. As another example, the Iseki '193 reference fails to teach or suggest the features of the adhesives as claimed in new claims 14 and 15. Further, there is no disclosure of all features of the laminates of claims 10-13.

Therefore, the Iseki '193 reference fails to disclose all features as instantly claimed. Under *Verdegaal Bros.*, Applicants respectfully submit that the rejection in view of Iseki '193 is overcome.

Accordingly, Applicants respectfully request the Examiner to reconsider, and to withdraw all rejections and allow the currently pending claims.

Conclusion

A full and complete response has been made to the Office Action. Applicants respectfully request that a timely Notice of Allowance be issued in the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application. The required fee of \$930.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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- ☒ Petition for three (3) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$930.00 for the extension of time.
- ☐ No fee is required.
- ☒ A check in the amount of \$1014.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. This form is submitted in triplicate.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s)

(Rev. 04/30/03)